

**Remarks**

Claims 1, 3-10, 12-15, and 16-22 are presently pending. Applicants have amended claims 1, 8, and 15. Applicants have canceled claims 2, 11, and 16. Applicants have added new claim 22. New claim 22 finds support in at least originally submitted claim 2. Claims 1, 8, and 15 have been amended to clarify. All claims stand rejected. Reconsideration is respectfully requested.

**Response to Examiner's Response to Applicants Traversal of the Restriction Requirement**

Applicants understand that the Examiner has made the Restriction Requirement Final. However, for the Examiner's convenience, Applicants are including the general argument on a petition to the Commissioner, submitted simultaneously herewith.

In response to Applicants' traversal submitted in the Response to the Restriction Requirement on January 27, 2005, the Examiner stated that Applicants' arguments are not found persuasive because "up to ten nucleotides" includes one nucleotide sequence as required in the restriction election requirement, which meets the Commissioner's requirement. The Examiner maintained that the amount of machine, and personnel time, and the additional amount of physical resources required to prosecute more than one sequence, will make it burdensome to prosecute multiple sequences in a single application. The Examiner concluded by making the restriction requirement Final.

Applicants respectfully request that all of the sequences, SEQ ID NOS: 1-4, be examined because the Commissioner has determined that up to ten nucleotide sequences will be examined in a single application. The Commissioner for Patents has recognized the substantial burden on the biotechnology industry if every sequence were to be treated as an independent and distinct invention and multiple sequences were not capable of being examined together. Thus, "the Commissioner has decided *sua sponte* to partially waive the requirements of 37 C.F.R. §1.141 *et seq.* and permit a reasonable number of such nucleotide sequences to be claimed in a single application... [a]ccordingly, in most cases, up to **ten** independent and distinct nucleotide sequences will be examined in a single application **without restriction.**" (M.P.E.P. § 803.04; *see also*, MPEP § 2434, allowing, "in most cases, up to 10 independent and distinct nucleotide

sequences" to be examined in a single application) (emphasis added). As such, Applicants request examination of only **four** sequences (SEQ ID NOS: 1-4), all of which are related.

SEQ ID NOS: 1-4 are PDHK cDNAs of *Brassica napus*, *Brassica rapa*, *Brassica oleracea* and *Brassica carinata*, respectively, and are related in that the sequences encode a Brassica PDHK and the sequences are all of a single genus (*i.e.*, *Brassica*). Accordingly, Applicants have provided evidence that the sequences are related and should be examined together.

Applicants also question the statutory and regulatory basis for the finding that each sequence in the application constitutes an independent and distinct invention within the meaning of 35 U.S.C. § 121. (*cf.* M.P.E.P. § 803.04 (wherein ten nucleotide sequences are allowed in one application)). Thus, Applicants respectfully requested the Examiner to provide the statutory and regulatory basis for the instant "sequence election."

As stated in the statute "if two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions." (35 U.S.C. § 121). The statute does not provide for a restriction where there are allegedly two or more inventions within a single claim. *In re Weber*, 580 F.2d 455, 459-460 (C.C.P.A. 1978)(J. Rich *concurring*). The rules implementing the statute recite "if two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted" (37 C.F.R. § 1.142) (emphasis added) and "in the first action on an application containing a generic claim to a generic invention (genus) and claims to more than one patentably distinct species embraced thereby, the examiner may require the applicant in the reply to that action to elect a species of his or her invention to which his or her claim will be restricted." (*Id.* at § 1.146). Accordingly, Applicants respectfully request the Commissioner rescind the restriction requirement and direct the examiner to examine SEQ ID NOS: 1-4.

#### **Information Disclosure Statement**

The Examiner has objected to apparently three submissions on the IDS. The first objection was to a GenBank citation of a sequence. The GenBank citation was taken from the cited article of J Biol Chem. 1998 Oct 9; 273(41):26618-23, which article was disclosed on the

IDS. Accordingly, the printout of GenBank Accession No.: AF038585 was properly disclosed. The second was to another GenBank citation of a sequence. The GenBank citation was also taken from J Biol Chem. 1998 Oct 9; 273(41):26618-23, which article was disclosed on the IDS. Accordingly, this printout of GenBank Accession No.: AF038586 was properly disclosed. In an effort to further the prosecution of the case, Applicants have included the two citations to the GenBank in the included Supplemental IDS with the year of publication. The third was to the MARILLIA et al. article below. A publication date was inadvertently not included with the MARILLIA citation. However, Applicants did submit the MARILLIA document and now properly submit the citation on the enclosed Supplemental IDS.

Other Documents

MARILLIA et al., "Metabolic engineering of Brassica seeds oils: improvement of oil quality and quantity and alteration of carbon flux." Plant Genetic Engineering: Towards the Third Millennium, 2000, pp. 182-188, Elsevier Science Publishing: New York.

GenBank Accession No.: AF038585, 1998.

GenBank Accession No.: AF038586, 1998.

**Claim to Priority**

Applicants have reviewed the priority claim and believe that a proper claim to priority has been made in the specification (paragraph [0001]). Applicants verified this through the PAIR system and the official filing receipt. If the Examiner maintains the contention that the priority claim is inadequate, Applicants respectfully request further clarification.

**Rejections under 35 USC§112, 1<sup>st</sup> ¶**

**1. Written Description**

Claims 1, 3-10, 12-15 and 17-20 stand rejected under 35 USC§112, 1<sup>st</sup> ¶, as failing to comply with the written description requirement. The Examiner contends that the claim(s) contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner contends that the

claims are broadly drawn to a genetically modified plant comprising a means for modulating mitochondrially generated acetyl-coA and/or respiration rate, and a process for modulating mitochondrially generated acetyl coA and/or respiration rate in a transgenic plant. The Examiner further contends that the specification fails to provide an adequate written description of the genus of nucleic acids, and therefore the claimed plants transformed therewith, are also inadequately described. Accordingly, one skilled in the art allegedly would not have recognized Applicant to have been in possession of the claimed invention at the time of filing. Applicants respectfully request reconsideration in light of this response and the amendments.

Applicants have amended claim 1 to incorporate the substance of claim 2. As claim 2 was not rejected, Applicants respectfully request reconsideration of the rejection. Claims 3-7 depend from claim 1 and Applicants respectfully request reconsideration of the rejection of claims 3-7 in light of the amendment.

Applicants have amended claim 8 to incorporate the substance of claim 11. As claim 11 was not rejected, Applicants respectfully request reconsideration of the rejection. Claims 9, 10 and 12-14 depend from claim 8 and Applicants respectfully request reconsideration of the rejection of claims 9, 10 and 12-14 in light of the amendment.

Applicants have amended claim 15 to incorporate the substance of claim 16. As claim 16 was not rejected, Applicants respectfully request reconsideration of the rejection. Claims 17-20 depend from claim 15 and Applicants respectfully request reconsideration of the rejection of claims 17-20 in light of the amendment.

## 2. Enablement

Claims 1, 3-10, 12-15 and 17-20 stand rejected under 35 U.S.C. 112, first paragraph, because the Examiner contends that the specification, while being enabling for SEQ ID No 1, does not reasonably provide enablement for other nucleic acids. Applicants have amended Claim 1 to incorporate the substance of claim 2. As claim 2 was not rejected, Applicants respectfully request reconsideration of the rejection.

## Rejections under 35 USC §101

Claims 1-20 stand rejected under the judicially created doctrine of obviousness-type

double patenting as being unpatentable over claims 1 and 10-14 of copending Application No. 10/222,075 (Marillia et al, Filing date Aug 15, 2003). Applicants respectfully request reconsideration of the rejection in light of the timely submitted terminal disclaimer accompanying the response in 10/222,075. That terminal disclaimer disclaims any term of any patent granted from that application that may extend beyond the term of this one.

**Rejections under 35 USC §102**

Claims 1, 3-6, 8-10, 12-15 and 17-20 stand rejected as being anticipated by US Pat. No. 6,265,636 (hereinafter referred to as the '636 patent) under 35 USC §102(e). Applicants have amended Claim to further clarify that Claim 1 comprises the elements of claim 2. As claim 2 was not rejected, Applicants respectfully request reconsideration of the rejection.

Claims 1, 3, 5, 6, 8, 12, 14, 15 and 17-20 stand rejected as being anticipated by US Pat No. 6,500,670 (hereinafter referred to as the '670 patent) under 35 USC §102(e). Applicants have amended Claim to further clarify that Claim 1 comprises the elements of claim 2. As claim 2 was not rejected, Applicants respectfully request reconsideration of the rejection.

**Examiner's Remarks**

Applicants extend their thanks to the Examiner for the indication that SEQ ID NO: 1 is free of the prior art. Applicants will pursue the allowance of the remaining claims.

**Conclusion**

Should the Office determine that additional items remain which might be resolved by a telephone conference, the Office is invited to contact the Applicants' attorney at the address or telephone number given below.

Respectfully submitted,

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